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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,019	12/08/2003	William C. Erbey	026083-00005	8850

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,019	Applicant(s) ERBEY ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20 and 34-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to communication filed 10/24/2005.

Election/Restrictions

2. Applicant's election with traverse of Group I and species I.A in the reply filed on 10/24/05 is acknowledged. The traversal is on the ground(s) that examination of all claims presents no undue burden on the examiner. This is not found persuasive because the applicant has not provided any explanation in support of the traversal. The examiner has provided a detailed explanation for restriction requirement in regards to how Groups I and Group II claims are treated as distinct inventions. The examiner had also identified two subclasses (Group I as pertaining to subclass 40 (Bill Distribution and payment) and Group II as pertaining to subclass 26 (Remote Ordering)).

The requirement is still deemed proper based on the foregoing explanation and is therefore made FINAL.

Accordingly claims 1-12, 20 and 34-45 have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of **35 U.S.C. 112**:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12, 20 and 34-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the step of approving the budget which does not relate to any other method step(s) of the claim concerning the work and invoicing. It appears that work order is created and transmitted regardless of the approval of the budget.

Claim 2 does not further limit any process step of the independent claim 1 upon which it depends. On the contrary, claim 2 limits the “automated commerce” which is not a process but a subject of the claim 1. At best claim 2 can be interpreted as limiting the system upon which claim 1 processes are based and not limiting the process of the method recited in claim 1.

Claims 4-8 recite conditions under which the budget exceeds a budget maximum. However, the budget approval has no relationship to the work order and/or invoice processing steps. This deficiency is also present in the independent claim 1.

Similar analysis of claims 6-8 also renders the claims indefinite.

Claims 9-12 are indefinite because “receiving a confirmation” does not relate to any process (steps) of claim 1. Same weakness is also present in claims 11 and 12.

Product claim 34 and system claims 35-45 also contain deficiency similar to method claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12, 20 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles US PGPub 2002/0111842 A1 (Miles) and further in view of Force (US PGPub 2004/0064389) (Force).

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Per claims 1-2 Miles teaches a method for performing automated commerce comprising:

Creating work order to two or more vendors, transmitting the work order to the vendor electronically, receiving invoice information from the vendor, approving the work order and approving the initiating payment of the approved invoice to the vendor (refer to para [007] through [0011]).

Miles fails to explicitly teach creating work order for each line item of a budget created for a transaction. However, Force in the same field of endeavor teaches these limitations (refer to para [0004], [0040] and [0041]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this process of creating work order for each line item of the budget as per Force because this would enable integration of the budget process with the invoicing of each line items of the budget to a corresponding vendor and monitor the invoicing as per the prevailing business practices. Electronic processing of the budget creation and interfacing the budget line items with invoicing would also allow analysis of the invoices corresponding to the individual line items with high degree of accuracy and efficiency.

Regarding claims 2-12 official notice is taken that various elements recited in the instant claims are old and well known in the art. For example, budget approval by a designated manager, using a workflow is old and well known in the art. In many organizations, such approval of the budget by more than one manager in a hierarchical organization is required. Likewise, receiving confirmation of the invoiced item by a vendor of a modified price is old and well known practice in commerce. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature as per the requirement of organization implementing the budget and invoice processing in order to conform to the applicable rules and procedures.

Claim 20 refers to various methods of initiating payment to the vendor. The examiner takes official notice that batch posting a payment is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention because batch

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posting would permit posting any number of payments at once thereby reducing work load and improving efficiency.

All limitations of claims 34 and 35 corresponds to method claim 1. Note that in view of the applied references within computerized art the limitations of claim 34 are inherently considered. No separate analysis therefore is deemed necessary since claim 34 is a treated as product to practice invention of claim 1.

Regarding claim 36, 38 and 44, the applied references fail to disclose the location of the processor, or the repository. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to house the processor in a terminal or a server since it has been held that rearranging parts of an apparatus involves only routine skill in the art. In re Japiske, 86 USPQ 70.

All other limitations of claims 37, 39-43 and 45 are old and well known and are already discussed in the applied prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-600PM M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

01/13/2005